

REMARKS**I. General**

Claims 1-40 are currently pending, and all are rejected by the Office Action mailed January 14, 2005. No claims are amended by this response. Applicant hereby traverses the rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

II. Claim Rejections

Claims 1-40 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,903,996 (hereinafter, *Morley*). Applicant traverses the rejections as follows.

A. Claims 1-16

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 1 requires, “a display for receiving the image output and displaying a displayed image in the first spectral band.” The original rejection (in the Office Action mailed May 19, 2004) cites the passage at column 9, lines 25-34 of *Morley* as teaching the feature; however, Applicant asserts that *Morley* does not teach this feature. While *Morley* discloses an item referred to as a “display” (see item 76 of figure 2a), the cited item does not perform the functions of “receiving the image output” or “displaying a displayed image in the first spectral band” as claim 1 requires. Instead, the cited item presents a range output to a user. The passage at column 13, lines 25-30 of *Morley* clearly shows that display item 76 does not meet the claim elements.

In response to Applicant’s arguments, the Office Action of January 14, 2005 asserts that display element 76 is not referenced as the claimed display, but rather, “The displayed images are output through the image intensifier.” Office Action of January 14, 2005 at 3. In other words, the Office Action asserts that the image intensifier of *Morley* is the claimed

display; however, the image intensifier does not “receive the image output,” as in claim 1 because an image intensifier receives the image itself, not image output. See figure 2b of *Morley*, which depicts light beams entering image intensifier 50. Accordingly, the image intensifier of *Morley* is not the same as the claimed display. At least because neither the displaying element 76 nor the image intensifier of *Morley* are the same as the claimed display, *Morley* does not teach each and every feature of claim 1.

Dependent claims 2-16 each depend either directly or indirectly from independent claim 1 and, thus, inherit all of the limitations of independent claim 1. Thus, *Morley* does not teach all features of claims 2-16. It is respectfully submitted that dependent claims 2-16 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Accordingly, Applicants respectfully request removal of the 35 U.S.C. § 102 rejection of claims 1-16.

B. Claims 17-24

Claim 17 recites, “generating a visual representation of the image at the display.” *Morley* does not teach the above-recited feature of claim 17. The passage at column 10, lines 20-25, which are cited by the Office Action of May 19, 2004 as teaching this feature, disclose using a Charge Coupled Device (CCD) 87 to capture an image electronically and to provide the image via an electrical interface. There is no teaching, however, of what happens to the image once it is sent via conductor 87b. In particular, there is no disclosure that a “visual representation” of the image is generated at a display.

In response to Applicant’s arguments, the current Office Action asserts that a CCD is inherently associated with a display device. Office Action of January 14, 2005 at 3. The current Office Action cites the Background of *Morley* (column 2, lines 55-60) as disclosing such inherency. *Id.* The Office Action’s assertions are incorrect. For a characteristic to be inherent, it must be “necessarily present” in the thing described. *See Continental Can Co. USA Inc. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). First, the cited portion of the Background merely describes a system that has a Cathode Ray Tube (CRT) associated with a CCD, but does not imply that CRTs or other displays are necessarily present when a system employs a CCD. Second, it is possible that systems exist that employ CCDs but do not include displays, such as systems that capture an image and save it to a

writable memory for storage without actually displaying the image. Accordingly, display devices are not necessarily present in systems that include CCDs, despite the Office Action's assertion. Thus, the above-recited feature of claim 17 is not taught by *Morley*.

Further, claim 17 recites, in part, "transmitting the video representation of the image to a display." *Morley* does not teach this feature of claim 17. The original Office Action cites column 9, lines 25-34 to teach the feature; however, such assertion is incorrect. As explained above, the display element (item 76 of figure 2a) is not the same as the claimed display because the cited display element displays only a range, rather than "generating a visual representation of the image," as in claim 17. See Col. 13, lines 26-30. The Office Action of January 14, 2005, at page 3, asserts that the image intensifier is the claimed display. However, the *Morley* system does not teach a component that transmits "the video representation of the image" to the intensifier because the image intensifier receives the image itself, rather than a video representation of the image. See figure 2b that shows light beams as the input to intensifier 50. Accordingly, the image intensifier of *Morley* is not the same as the claimed display. At least because neither the displaying element 76 nor the image intensifier of *Morley* are the same as the claimed display, *Morley* does not teach each and every feature of claim 17.

Dependent claims 18-24 each depend either directly or indirectly from independent claim 17 and, thus, inherit all of the limitations of independent claim 17. Thus, *Morley* does not teach all claim limitations of claims 18-24. It is respectfully submitted that dependent claims 18-24 are allowable at least because of their dependence from claim 17 for the reasons discussed above. Accordingly, Applicant respectfully requests removal of the 35 U.S.C. § 102 rejection of claims 17-24.

C. Claims 25-32

Claim 25 recites, "transmitting the IR image representation to a display." *Morley* does not teach the recited feature of claim 25. As explained above with regard to claim 1, the component referred to in the reference as a "display" (item 76 of figure 2a in *Morley*) presents only a range output to a user. See rejection of claim 17 in the Office Action of May 19, 2004. The cited item does not generate a visual representation of an image, and therefore, there is no component that transmits, "the IR image representation to a display," as claim 25

recites. Thus, the passage at column 9, lines 25-34 fails to teach the above-recited feature of claim 25.

The Office Action of January 14, 2005, at page 3, asserts that the image intensifier of *Morley* is the same as the claimed display; however, such assertion is incorrect. There is no component that transmits “the IR image representation” to the intensifier because the intensifier’s input is the image itself, not a representation. See figure 2b that shows light beams as the input to intensifier 50. Accordingly, *Morley* does not teach the above-recited feature of claim 25.

Dependent claims 26-32 each depend either directly or indirectly from independent claim 25 and, thus, inherit all of the limitations of independent claim 25. Thus, *Morley* does not teach all claim limitations of claims 26-32. It is respectfully submitted that dependent claims 26-32 are allowable at least because of their dependence from claim 25 for the reasons discussed above. Accordingly, Applicant respectfully requests removal of the 35 U.S.C. § 102 rejection of claims 25-32.

D. Claims 33-40

Claim 33 recites, “a display for receiving and displaying the image output.” *Morley* does not teach the recited feature of claim 33. Contrary to the assertion of the Office Action of May 19, 2004, the passage at column 10, lines 20-25 of *Morley* fails to teach the above-recited feature. As explained above with regard to claim 17, the referenced passage teaches using a CCD to capture and provide an image electronically; however, the passage does not teach “displaying the image output,” as claim 33 recites, because the passage does not teach what happens to the image once it is sent via conductor 87b. Specifically, there is no disclosure that an image output is displayed, and *Morley* does not teach a display associated with the CCD.

Further, while the Office Action asserts that a display is inherently associated with a CCD, such an assertion is not true. As shown above with regard to claim 17, the Office Action fails to show that a display device is “necessarily present” with a CCD. For example, it is possible to create a device that uses a CCD to capture an image and store it to memory without actually displaying the image, thereby illustrating that there is no inherent display. It

should also be noted that the cited image intensifier is not the same as the claimed display because the *Morley* intensifier receives the image itself as input, rather than receiving image output. Thus, *Morley* does not teach the above-recited feature of claim 33.

Dependent claims 34-40 each depend either directly or indirectly from independent claim 33 and, thus, inherit all of the limitations of independent claim 33. Thus, *Morley* does not teach all claim limitations of claims 34-40. It is respectfully submitted that dependent claims 34-40 are allowable at least because of their dependence from claim 33 for the reasons discussed above. Accordingly, Applicant respectfully requests removal of the 35 U.S.C. § 102 rejection of claims 34-40.

III. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 46030/P040US/10407171 from which the undersigned is authorized to draw.

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Respectfully submitted,

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